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In re Application of:	:	
SCHAFER, Hans-Jurgen	:	
U.S. Application No.: 10/531,394	:	DECISION ON PETITION UNDER
PCT No.: PCT/EP03/11369	:	37 CFR 1.47(b)
International Filing Date: 14 October 2003	:	
Priority Date: 14 October 2002	:	
Attorney's Docket No.: 040275	:	
For: A PROCESS AND AN APPARATUS	:	
FOR COATING PRINTED CIRCUIT	:	
BOARDS WITH LASER-	:	
STRUCTURABLE, THERMALLY	:	
CURABLE SOLDER LACQUERS	:	
AND ELECTRORESISTS	:	

This decision is issued in response to the "Petition Under 37 CFR 1.47(b) To Make Application As Assignee On Behalf Of And As Agent For Inventor" filed 27 December 2005. Deposit Account No. 02-4553 will be charged the required \$200 petition fee.

**BACKGROUND**

On 14 October 2003, applicant filed international application PCT/EP03/11369. The application claimed a priority date of 14 October 2002 and designated the United States. On 29 April 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 14 April 2005.

On 14 April 2005, petitioner filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and an English translation of the international application.

On 24 October 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration acceptable under 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date were required.

On 27 December 2006, petitioner filed a response to the Notification Of Missing Requirements. The response included payment of the \$130 surcharge for filing the declaration later than thirty months after priority date, and the petition considered herein. The petition seeks acceptance of the application without the signature of the sole inventor, whom petitioner states has refused to execute the application papers.

### DISCUSSION

A grantable petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The present petition satisfies items (1), (3), and (6).

Regarding item (1), petitioner has authorized a charge to Deposit Account No. 02-4553 for required fees. Pursuant to this authorization, the Deposit Account will be charged the required \$200 petition fee. Item (1) is therefore satisfied.

Regarding item (2), where it is asserted that the inventor has refused to execute the application papers, section 409.03(d) of the MPEP states that a "copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Here, petitioner has provided a declaration by Ms Ute COLLIN, with accompanying exhibits. This declaration provides a firsthand statement that the nonsigning inventor has been provided with the complete application papers, as required. The materials also show that the inventor was asked to sign a power of attorney in the international application, but that he refused to execute the power of attorney without additional payment. However, the petition does not indicate that the inventor has been provided with, and refused to execute, an oath or declaration with respect to the present United States national stage application. The apparent refusal to execute a power of attorney in the international application is not equivalent to the inventor's refusing to execute an oath or declaration for the United States national stage application (a declaration which would not need to include a power of attorney). Before item (2) can be considered satisfied, petitioner must provide firsthand evidence (with documentary support) confirming that the inventor has been provided with a declaration with respect to the present United States application and has refused to execute such declaration.

Based on the above, the present record does not satisfy item (2).

Regarding item (3), the petition includes an express statement of the last known address of the nonsigning inventor. Item (3) is satisfied.

Regarding item (4), the petition includes a declaration that sets forth the name, residence, and citizenship of the nonsigning inventor, as required and is executed by two other individuals (Dr. Jorg Wonnemann and Dr. Gregor Frank). However, a grantable petition requires that the declaration be executed on behalf of the nonsigning inventor by the 37 CFR 1.48(b) applicant, in this case, Atotech Deutschland GmbH (hereinafter "Atotech"). Petitioner must supply a new declaration executed on behalf of the nonsigning inventor by Atotech. The declaration should expressly identify Atotech and set forth the name and capacity of the authorized person signing the declaration on behalf of Atotech.<sup>1</sup> The declaration must include all other information required by 37 CFR 1.497, including the name, residence, and citizenship of the nonsigning inventor. Until such a declaration is provided, item (4) is not satisfied.

Regarding item (5), section 409.03(f) of the MPEP states the following:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Petitioner here asserts that it has a proprietary right to the invention in the present application based upon German law and the inventor's assignment to Atotech of the underlying German priority applications. Pursuant to MPEP section 409.03(f), a showing of such a proprietary interest requires the following:

an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Petitioner here has provided a "Legal Opinion" from Dr. F. Nielsen, a German attorney, which concludes that under the applicable law, Atotech is "the sole owner" of the German patent applications and patent applications based thereon (including the present US national stage application). Petitioner has also provided a statement from Dr. Thomas Albrecht, a second German patent attorney, who concludes that the inventor no longer has rights in patent applications filed abroad that are based on the German priority applications. Both of these legal

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<sup>1</sup> If the title of the person signing on behalf of Atotech does not provide that person with apparent authority to sign on behalf of Atotech, the declaration should expressly state that the person is so authorized. See MPEP § 324(V)

opinions reference specific German laws (Dr. Nielsen relies on German Civil Code sections 398, 403, and 413; Dr. Albrecht relies on section 6 of the German patent law). However, petitioner has not provided copies of these German laws (in the English language), as required by the MPEP. Applicants must provide these additional materials before it can be concluded that an adequate showing has been made regarding Atotech's proprietary interest in the present application. Item (5) is therefore not satisfied.

Regarding item (6), the petition includes the required statement that granting of the present petition is necessary to preserve the rights of Atotech. Item (6) is satisfied.

Based on the above, petitioner has failed to satisfy all the requirements for a grantable petition.

### CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)" and must include the materials required to satisfy items (2), (4), and (5) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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